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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,465

11/15/2005

Atakan Peker

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6325

71897

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02/11/2009

KAUTH, POMEROY, PECK & BAILEY, LLP

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

02/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,465	<b>Applicant(s)</b> PEKER ET AL.	
	<b>Examiner</b> George P. Wyszomierski	<b>Art Unit</b> 1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/1/08 (RCE, Amendment, Disclaimer).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,8-10,12 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-10,12 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 1, 2008 has been entered. Claims 1-5, 8-10, 12, and 17-20 are pending in this application.

2. The following is a quotation of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5, 8-10, 12, and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 as amended states that the amorphous alloy in the invention is “free from Ni, Al and Be”, and has a “glass transition temperature lower than 400<sup>0</sup>C”. The specification as filed did not disclose such a material to one of skill in the art reading said specification.

First, any specific mention in the specification of the lack of nickel, aluminum, or beryllium is mentioned in the alternative form only. Note, for instance, page 2, lines 5-11, in

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which three separate preferred embodiments are disclosed, incorporating no Nickel, no Aluminum, and no Beryllium respectively. On page 3, lines 8-9, the alloy of the invention is “selected from the group consisting of...Zr/Ti base with no Ni, Zr/Ti base with no Al, and Zr/Ti base with no Be.” Page 8, lines 12-13 states that the composition can be “preferably selected to be free of Ni or Al or Be” [emphasis added].

Giving Applicant the broadest leeway in interpreting the specification, and assuming that the above alternative language could be combined to result in a material that is free from Ni, Al and Be, one would next need to determine what materials having such a composition would have a glass transition temperature lower than 400<sup>0</sup>C. Pages 4-5 of the specification incorporate by reference a number of prior art documents, and indicates that those documents disclose exemplary materials of the invention. The vast majority of the compositions in those documents contain at least one of Ni, Al, or Be, and thus would not be representative of the invention as claimed. The Inoue et al. Appl. Phys. Lett. article and JP Publication 2001-303218 do disclose materials free of Ni, Al and Be; however the glass transition temperatures of those materials are well in excess of 400<sup>0</sup>C.

Nothing described in the specification as filed would have taught one of ordinary skill in the art a material possessing all of the features as required by the independent claim. Thus, claim 1 and all claims dependent thereon are held to have not been described in the specification as originally filed.

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4. Claims 1-5, 8-10, 12 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 is directed to an alloy that is free from Ni, Al and Be. However, claim 2 permits a range of 5-60% Ni and 0-50% Be and Al. Claim 3 permits a range of 20-40% Ni, and actually requires 7.5-15% Al to be present. These conflicting recitations of the invention render it unclear what materials would fall within the scope of the invention.

5. Claims 1-5, 8-10, 12 and 17-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/524954.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims and the '954 claims are directed to bulk solidifying amorphous alloys having certain compositions and properties. Claims 14-16 of the '954 application are directed to the lack of Ni, Al, or Be. Claims 7, 8, 10, 11, 18 and 19 of the '954 application are virtually identical to instant claims 2-5, 8, 17 and 19 respectively. Claim 13 of the '954 application is analogous to instant claim 12. Instant claim 10 merely recites properties which would easily be achieved by one skilled in the art by varying the precise composition of the prior art materials within the constraints as recited in, e.g. '954 claims 2, 3 and 9. Instant claim 18 defines nothing more than conventional fillers that would be used in conjunction with the cement of '954 claim 18. While the '954 claims do not recite the phrase "replication of at least one surface feature of at least one tooth" as required by the instant claims or the "crown, a bridge or a cap" as recited in instant claim 20, the examiner's position is that such terminology

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falls within the scope of the "medical implant for placement into a specific implant region within a biological organism" recited in '954 claim 1. Thus, no patentable distinction is seen between the articles defined in the instant claims and those defined in the claims of the '954 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. The terminal disclaimer filed on December 1, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on application no. 10/523,465 has been reviewed and is NOT accepted because that is the number of the present application. A corrected disclaimer should be filed referencing application no. 10/524,954.

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8. The prior art does not disclose or suggest any material having the combination of compositional limitations and properties as recited in independent claim 1. Thus, no prior art is being applied against the instant claims at this time.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/George Wyszomierski/  
Primary Examiner  
Art Unit 1793

GPW  
February 5, 2009